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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,617	06/17/1999	YOSHIHIRO IDA	P18051	5530

7055 7590 06/15/2006

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EXAMINER

GIBBS, HEATHER D

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/334,617	<b>Applicant(s)</b> IDA ET AL.	
	<b>Examiner</b> Heather D. Gibbs	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-28,30-32 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 30-32 is/are allowed.
- 6) ☒ Claim(s) 27 and 34-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on March 31, 2006 has been entered and made of record.

Claims 24-26,28,30-32,34-42 are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 24-26,30,34-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Feder (US 5,872,845).

Regarding claim 24, which is representative of claim 30, Feder teaches a server apparatus connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile apparatus via the Internet, the server apparatus comprising: a memory configured to store reception capabilities regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive, the receiving Internet facsimile apparatus being distinct from the server apparatus, the reception capabilities

being distinct from the facsimile data; and a controller configured to receive facsimile data from the transmitting Internet facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving Internet facsimile apparatus (Col 10 Lines 19-25; 34-45).

For claim 25, Feder teaches wherein the reception capability regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive comprises a type of file data that the Internet receiving facsimile apparatus can receive (Col 10 Lines 20-25).

Considering claim 26, Feder teaches wherein the type of file data is at least one of MH, MR, MMR, and JPEG (Col 10 Lines 20-25).

Considering claim 34, Feder teaches wherein the controller transmits the transformed facsimile data to the receiving Internet facsimile apparatus via the Internet (Fig 1).

Regarding claim 35, Feder discloses the controller being further configured to determine whether the reception capabilities of the receiving Internet facsimile apparatus are stored in the memory (Col 10 Lines 4-25).

For claim 36, Feder teaches determining whether the reception capabilities of the receiving Internet facsimile apparatus are stored (Col 10 Lines 4-25).

For claims 37-38, Feder discloses wherein the reception capabilities include at least one of a compression format and a resolution (Col 2 Lines 58-61).

Regarding claims 39-40, Feder teaches the controller being configured to determine whether the received facsimile data is of a type that corresponds to reception capabilities of the receiving Internet facsimile apparatus, to transmit the received facsimile data to the receiving Internet facsimile apparatus if the received facsimile data type corresponds to the reception capabilities, and if the received facsimile data type does not correspond to the reception capabilities of the receiving Internet facsimile apparatus, to transform the received facsimile data into a facsimile data type that corresponds to the reception capabilities of the receiving Internet facsimile apparatus (Fig 1; Col 10 Lines 4-45).

Considering claims 41-42, Feder discloses wherein the facsimile data is facsimile data that has been converted into an Internet facsimile format and the transformed facsimile data is in the Internet transmission format (Col 10 Lines 34-45).

#### ***Allowable Subject Matter***

4. Claims 28,31-32 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches a controller configured to receive an email from the facsimile apparatus, to determine whether or not an e-mail address included in the received e-mail is a predetermined address, the predetermined address indicating the capabilities of the facsimile apparatus to be stored in the memory, the controller being further configured to store the capabilities of the

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facsimile apparatus in the memory, in response to a determination that the e-mail address is the predetermined address.

### **Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D. Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Heather D Gibbs  
Examiner  
Art Unit 2625

hdg



THOMAS D. LYLE  
JULY 17 2009